

Remarks/Arguments

In the telephone interview with Examiner Avi Gold on November 29, 2004, the rejections of Claims 1-36 were discussed, along with questions concerning the prima facie case of obviousness (see Errors in Rejection below).

Errors in Rejection

The assignee respectfully asserts that it was erroneous to reject Claims 1-36, under 35 U.S.C. 103, over U.S. Patent 6,177,905 B1 to Welch, in view of U.S. Patent 6,795,858 B1 to Jain et al. A prima facie case of obviousness has not been established.

Argument regarding Claims 1-23, 35 U.S.C. 103 and lack of a prima facie case of obviousness:

As stated in MPEP 2142: "The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness." As stated in MPEP 2143 and 2143.03, a requirement for establishing a prima facie case of obviousness is that the reference or references must teach or suggest all the claim limitations.

A. Limitations in the Rejected Claims Which Are Not Described in the References Relied On:

The following language from rejected Claim 1 provides an example of limitations in the rejected claims which are not described in the references: "acquiring location data regarding a user from a plurality of location sources." Similar language is found

in rejected Claims 13 and 25. This language should be considered in light of FIGS. 1, 3, 4, 5, and 6. This is not described in the references. In contrast, the Welch '905 reference describes the use of only one mobile device at a time. See Welch at Col. 1, Lines 35-39, and Welch FIG. 1.

The following language from rejected Claim 1 provides another example of limitations in the rejected claims which are not described in the references: "creating a collection of said location data regarding said user." Similar language is found in rejected Claims 4, 7, 10, 13, 16, 25, and 28. Consider "creating a collection of said location data regarding said user" in the rejected claims, in light of the Specification's paragraph 0047, and the table in paragraph 0048. The table is a simplified example of a collection of location data, entitled "Location data for husband," and having columns marked: "Rank," "Location Source," and "Location." This claimed subject matter is not described in the references relied on.

A search of the text of the references shows that they do not contain these terms found in rejected Claim 1, for example: "acquiring" or "collection." The references do not contain these similar terms, either: "acquire," "collect," "accumulate," or "get."

The following language from rejected Claim 2 provides another example of limitations in the rejected claims which are not described in the references: "filtering data in said collection to remove misleading data." Similar language is found in rejected Claims 5, 8, 11, 14, 17, 20, 23, 26, 29, 32, and 35. On this point, the Office action at Pages 3-4 mistakenly asserts that Welch teaches this "filtering," and cites a portion of Welch that merely describes a "matcher" for determining whether a

present “geographical location matches the specified geographical location.”

The following language from rejected Claim 7 provides another example of limitations in the rejected claims which are not described in the references: “ranking items in a collection of location data regarding a user, according to expected utility.” Similar language is found in rejected Claims 1, 4, 10, 13, 16, 25, 28, 31, and 34.

The following language from rejected Claim 3 provides another example of limitations in the rejected claims which are not described in the references: “consolidating data in said collection to determine the most likely location of said user.” Similar language is found in rejected Claims 6, 9, 12, 15, 18, 21, 27, 30, 33, and 36. Consider this claim language in light of the Specification, Paragraph 0044 of the published version:

The present invention would be capable of consolidating location data found in a collection of location data, to determine the most likely location of a user. For example, a user may be provided with the most likely location of another user who is being tracked, as a result of the system determining a consensus location, based on data from more than one location source. A consensus location, indicated by data from more than one location source, would provide greater certainty than data from any one location source taken alone.

The Office action at Page 4 mistakenly asserts that Welch teaches this “consolidating data,” and cites a portion of Welch that merely describes “the mobile device” with a location-triggered reminder. Welch at Col. 1, Lines 43-53.

B. Why the References, Taken as a Whole, Do Not Suggest the Claimed Subject Matter:

The cited references do not suggest a solution involving above-quoted subject matter of the rejected Claims. The references do not suggest acquiring location data "from a plurality of location sources," where the location sources are separate devices associated with one person, as shown in FIGS. 1, 3, 4, 5, and 6 for example.

Teaching away is the antithesis of suggesting the claimed subject matter. FIG. 1 of Welch '905, showing only one mobile device, teaches away from "a plurality of location sources" found in rejected claim 1. The written description of Welch '905, describing use of only one mobile device at a time, also teaches away from "a plurality of location sources" found in rejected claim 1. Welch at Col. 1, Lines 35-39 repeatedly states: "the device alerts him or her," in describing the "location-triggered reminder." The Office action at Page 2 cites a portion of Welch that states: "a mobile user device--such as a personal digital assistant (PDA), a wireless telephone, a car phone, or any other programmable device that the user generally has with him or her--is equipped with a global positioning system (GPS) receiver and is programmable by the user to alert the user" Welch at Col. 1, Lines 25-30.

C. Why Features Disclosed in One Reference May Not Properly Be Combined with Features Disclosed in Another Reference:

As stated in MPEP 2143 and 2143.01, a requirement for establishing a prima facie case of obviousness is that there must be some suggestion or motivation to combine reference teachings. As stated in MPEP 2143.01: "The mere fact that references can

be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."

The Office action at Page 3 proposes to combine reference teachings, in rejecting Claims 1, 7, 13, 19, 25, and 31 containing this language: "ranking items in said collection according to expected utility." (Similar language is found in rejected Claims 4, 16, 22, 28, and 34.) However, there must be some suggestion or motivation to combine reference teachings, and it is absent in this case. Neither Welch nor Jain suggest any combination of Welch's location-triggered reminder in a mobile device, with Jain's method and apparatus to select from a group of servers a particular server that can provide content to a client in an optimal manner. Thus a prima facie case of obviousness has not been established.

D. Differences Between the References, and the Claimed Invention as a Whole:

As quoted in MPEP 2141.02, a "patentable invention may lie in the discovery of the source of a problem This is part of the 'subject matter as a whole' which should always be considered in determining the obviousness of an invention under 35 U.S.C. 103." (Citing *In re Spinnoble*). In the present case, the Specification (Pages 1-2, or Paragraph 5 of the published version) points out a problem:

... location information from one source may be inconsistent with information from another source. For example, a husband and wife may share a tracking device that is embedded in their car. In addition, the husband may have a location-aware mobile phone. The wife may use the car to drive to the wife's office, after giving the husband a ride to his office. Then information from the mobile phone, indicating that the husband is at his office, will be inconsistent

Appl. No.: 09/773,193

Reply to Office action of November 9, 2004

with information from the tracking device in the car, indicating that the husband is at the wife's office.

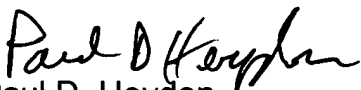
A solution is described this way in the Summary of the Invention: "make proper use of all available location information, by first collecting and then evaluating information from multiple sources." Specification Page 2, or Paragraph 10 of the published version.

Here is a source of a problem: the above-mentioned problem of location information from one source being inconsistent with information from another source. The references the Office action relies on do not identify this problem. This should be considered as evidence of nonobviousness.

In conclusion, the references do not teach or suggest all the claim limitations, and a prima facie case of obviousness has not been established.

Assignee respectfully submits that the rejection of Claims 1-36 should be withdrawn, and requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,



Paul D. Heydon

Attorney for Assignee

Reg. No. 46,769

3004 Nacogdoches Road

San Antonio, TX 78217

(210) 930-4300